



JFW 2161

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

Applicant(s): Uday P. Nadkarni

Application No: 09/904,062

Art Group: 2161

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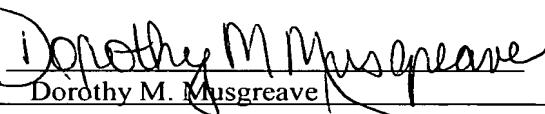
Examiner: Coby, Frantz

Attorney Docket No: P21,411-B USA

Title: SKILLS DATABASE MANAGEMENT  
SYSTEM AND METHOD

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 27, 2006.

  
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Dorothy M. Musgrave

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S REPLY**

This is being filed in reply to the Examiner's Answer mailed February 27, 2006. The Commissioner is authorized to charge deposit Account No. 19-5425 for any fees in connection with this reply or this appeal in general.

The Examiner's Answer indicates that the Supplemental Declaration is being rejected not based on sufficiency, but rather timing. Applicant respectfully submits that this issue was not raised previously by the Examiner and, as such, Applicant has not had an opportunity to respond to this rejection in the ordinary course of prosecution. Following the submission of the Supplemental Declaration, the Examiner rejected it based on an alleged insufficiency, and not on timeliness. The Examiner stated in the Advisory Action of July 11, 2005 as follows:

The supplemental affidavit failed to show that every claim limitations independent as well as dependent have specifics that correspond to specific part of the Applicant's Printout in Exhibits A-D. If the Applicants believe that

the invention as claimed is described in the Applicants' Exhibits as indicated in the declaration, an indication as to where the cited claims language are taught in the portion of the Applicants' Exhibits B-D would not be difficult to show."

Nowhere in this action was the issue of its timeliness raised. By waiting until the appeal process to raise the issue, the Examiner has denied Applicant an opportunity to respond or provide a showing of good and sufficient reasons under MPEP §715.09 (c) why the Supplemental Declaration is necessary and was not earlier presented.

Furthermore, Applicant submits that issues of timeliness are not appropriate for appeal, but rather should be addressed in a petition. As set forth in MPEP §715.09, in relevant part:

Review of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. *In re Deters*, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); *Ex parte Hale*, 49 USPQ 209 (Bd. App. 1941).

Therefore, Applicant questions whether this appeal should continue now that the reason for the Supplement Declaration's rejection has been identified as a lack of timeliness.

Respectfully submitted,



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